Case Docket No. 5352ZYXI-IIWV

In re application of Harold L. Kohn et al.

Serial No.: 08/003,208

Filed: January 12, 1993

For: AMINO ACID DERIVATIVE ANTICONVULSANT

94 OCT 13 AM 7:38
GROUP: 120

The Commissioner of Patents and Trademarks
Washington, DC 20231

Sir:

Transmitted herewith is an Information Disclosure Statement in the above-identified application.

[ ] Please charge Deposit Account No. _____ in the amount of $_____. A duplicate copy of this sheet is attached.

[ ] A check in the amount of $_____ is attached.

[X] The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-3886. A duplicate copy of this sheet is attached.

[X] Any fee under 37 C.F.R. §1.17(i)(1) or §1.17(p) which may be required by this communication but which was not submitted herewith.

Respectfully submitted,

Dated: October 5, 1994

Mark J. Cohen
Registration No. 32,211

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530
(516) 742-4343

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#6 PATENTS
10-13-94

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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Harold L. Kohn et al.

Examiner: Criares, T.

Serial No.: 003,208

Art Unit: 1205

Filed: January 12, 1993

Docket: 5352ZYXI-IIWV

For: AMINO ACID DERIVATIVE ANTICONVULSANT

Dated: October 5, 1994

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

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INFORMATION DISCLOSURE STATEMENT

Sir:

In compliance with the duty of disclosure pursuant to 37 C.F.R. §1.56,1.97, 1.98, applicants are making of record herein art for consideration by United States Patent and Trademark Office. The art is specifically listed on accompanying PTO-1449 form at hereinbelow:

U.S. Patent No. 4,873,241 to Napier et al., issued October, 1989.

U.S. Patent No. 4,018,826 to Gless Jr. et al., issued April, 1977.

U.S. Patent No. 3,340,147 to Martin et al., issued September, 1967.

U.S. Patent No. 3,657,341 to Thorne et al. issued April, 1972.

U.S. Patent No. 2,721,197 to Sheehan, issued October, 1955.

U.S. Patent No. 3,707,559 to Mazur et al., issued December, 1972.

U.S. Patent No. 4,595,700 to Donald et al., issued June, 1986.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, DC 20231 on October 5, 1994.

Dated: October 5, 1994

Mark J. Cohen

Mark J. Cohen

ras/5352ZYXI-IIWV.RES

U.S. Patent No. 4,618,708 to Roques et al., issued October, 1986.

U.S. Patent No. 4,260,684 to Schutt, issued April, 1981.

U.S. Patent No. 4,303,673 to Biedermann et al., issued December, 1981.

U.S. Patent No. 4,513,009 to Roques et al., issued April, 1985.

U.S. Patent No. 4,372,974 to Fish et al., issued February, 1983.

U.S. Patent No. 2,676,188 to Bruce et al., issued April, 1954.

European Patent Application No. 0,263,506 published October, 1987.

European Patent Application No. 0,194,464 published February, 1980.

Great Britain Patent Application No. 1,051,220 published December, 1966.

German Patent Application No. 1,927,692 published December, 1969.

European Patent Application No. 0,007,441 published February, 1980.

Swiss Patent Application No. 0,393,355 published October, 1965.

Belgium Patent Application No. 0,885,303 published March, 1981.

European Patent Application No. 0,046,707 published March, 1982.

European Patent Application No. 0,042,626 published December, 1981.

European Patent Application No. 0,038,758 published October, 1981.

European Patent Application No. 0,400,400 published May, 1990.

Chemical Abstracts, Vol. 92; No. 7:51712r (02/18/90).

Chemical Abstracts, Vol. 96; No. 5:35710r (02/01/82).

Chemical Abstracts, Vol. 101; No. 9:72124v (08/27/84).

Chemical Abstracts, Vol. 91; No. 21:175147; (11/19/79)

Chemical Abstracts, Vol. 97;145266d (1982).

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Kohn, et al. (1988) Brain Research 457: 371-375, Marked Stereospecificity in a New Class of Anticonvulsants.

White, et al. (1981) JACS, 103:4231-4239, Active-Site-Directed Inhibition of alpha-Cymotrypsin by Deaminatively Produced Carbonium Ions: An Example of Suicide of Enzyme-Activated-Substrate Inhibition.

Legall, et al. (1988) Int. J. Protein Res., 32:279-291 Synthesis of Functionalized Non-Natural Amino Acid Derivatives via Amidoalkylation Transformations.

Cortes, et al. (1985) J. Med. Chem., 28:601-606, Effects of Structural Modification of the Hydrantion Ring on Anticonvulsant Activity.

Ikeda, et al. (1977) Tetrahedron, 33(5): 489-495, Photochemical Synthesis of 1,2,3,4-Tetrahydroisoquinolin-3-ones from N-Chloroacetylbenzylamines.

Conley, et al. (1987) J. Med. Chem., 30(3):567-574, Functionalized DL-Amino Acid Derivatives, Potent New Agents for the Treatment of Epilepsy.

Garcia, et al. (1984) Tetrahedron Letters, 25(42): 4841-4844, New Synthetic "Tricks" Triphenylphosphine-Mediated Amide Formation from Carboxylic Acids and Azides.

Rebek, et al. (1979) J. Am. Chem. Soc., 101(3): 737, On the Rate of Site-Site Interactions in Functionalized Polystyrenes.

Katritzky, et al. (1990) J. Org. Chem, 55: 2206-2214, Benzotriazole-Assisted Synthesis of Monoacyl Animals and Their Peptide Derivatives.

Lipshutz, et al. (1983) J. Am. Chem. Soc., 105: 7703-7713, Heterocycles as masked Diamide/Dipeptide Equivalents. Formation and Reactions of Substituted 5-(Acylamino)oxazoles as Intermediates en route to the Cyclopeptide Alkaloids.

Lipshutz, et al. (1983) J. Org. Chem. 48: 3745-3750, An Approach to the

Cyclopeptide Alkaloids (Phencyclopeptines) via Heterocyclic Diamide/Dipeptide Equivalents. Preparation and N-Alkylation Studies of 2,4(5)-Disubstituted Imidazoles.

Roques, (1987) 193rd ACS National Meeting, Amer. Chem. Society, April 5-10, 1987, Use of Various Metallopeptidase Inhibitors to Study the Physiological Role of Endogenous Neuropeptides.

Kohn, et al. (1990) J. Med. Chem. 33: 919-926, Preparation and Anticonvulsant activity of a Series of Functionalized α-Aromatic and α-Heteroaromatic Amino Acids.

Lipshutz, et al. (1984) JACS, 106(2):457-459, "Heterocycles in Synthesis: Chiral Amino Acids/Dipeptides via a Novel photooxidative Cleavage of Trisubstituted Imidazoles".

Kohn, et al. (1988) Chemistry in Britain, pp. 231-233, New Antiepileptic Agents.
European Search Report and Annex for EP 87 11 4623.

European Search Report and Annex for EP 86 10 1865.

European Search Report for EP 90109596.8

European Search Report and Annex for EP 87 11 4623.9.

All the references listed herein were cited in at least one of the parent applications. More specifically, the present application is a Continuation-in-Part of U.S. Patent Application 710,610 filed on June 4, 1991, which is a continuation in part of U.S. Patent Application 354,057, filed May 19, 1989, and U.S. Patent Application Serial No. 392,870 filed August 11, 1989. U.S. Patent Application Serial No. 354,057 is a Continuation-in-Part of U.S. Patent Application Serial No. 080,528 filed July 31, 1987, which is a Continuation-in-Part of U.S. Patent Application Serial No. 916,254, filed October 7, 1986, which is a Continuation-in-Part of U.S. Patent Application Serial No. 702,195, filed on February 15, 1985. U.S. Patent Application Serial No. 392,870 is a Continuation

application of U.S. Patent Application Serial No. 080,528 filed July 13, 1987 which is a Continuation-in-Part of U.S. Patent Application Serial No. 916,254, filed October 7, 1986 which is a Continuation-in-Part of U.S. Patent Application Serial No. 702,195, filed on February 15, 1985. In other words, these references were made of record in at least one of the applications indicated hereinabove. Applicants are claiming benefit of all the patent applications listed hereinabove and rely upon them for an earlier filing date under 35 U.S.C. §120. Therefore, in accordance with 37 C.F.R. §1.98(d) applicants are not supplying a copy of any of these references listed hereinabove. However, if the United States Patent and Trademark Office would like a copy of any of those references, Applicants would be happy to supply a copy thereof.

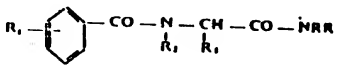
Many of the references listed in the PTO-1449 form are in the English language. Consequently, the concise explanation of the relevance of those references required by 37 C.F.R. §1.98(a)(3) has been met.

But, Belgium Application no. 885,303, European Patent Application Nos. 038,758 and 046,707 and German Patent Application No. 1,927,692 are not in the English Language. However, during prosecution of the parent applications, Applicants submitted the English version language of Search Reports respecting the foregoing counterparts thereof in which these references were cited. Copies of those search reports are in the File Wrapper of the parent applications, especially U.S. Patent Application Serial No. 710,610. Therefore, Applicants have complied with the concise explanation of relevance pursuant to 37 C.F.R. §1.98(a)(3).

However, one of the references, namely Swiss Patent No. 393,355, is only listed in the Office Action cited by the Examiner in one of the parent applications. Said reference is

discussed in several of the Information Disclosure Statements in the parent applications. However, for the convenience of the Examiner, Applicants reiterate a summary of this reference.

Swiss Patent No. 393,355 discloses compounds of the formula:



in which

R_1 is hydrogen, hydroxy, alkyl, alkoxy, benzyloxy,

R_2 is hydrogen, alkyl, phenyl or alkoxyphenyl, and

R_3 is hydrogen or alkyl or

R and R_1 are independently hydrogen, alkyl or oxyalkyl, or together with the atoms to which they are attached form a ring.

Consideration of this Information Disclosure Statement is respectfully requested since the art may be material to the examination of the present application as defined in 37 C.F.R. §1.56(a).

Inasmuch as this Information Disclosure Statement is being filed prior to the issuance of a first Office Action on the merits in the above-identified application, no fee or certificate under 37 C.F.R. §1.97(e) is required.

Respectfully requested,

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MJC:ras